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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,913	01/05/2004	Jon B. Schneider	25815-10901	1982

7590 04/05/2005

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EXAMINER	
GELLNER, JEFFREY L	
ART UNIT	**PAPER NUMBER**
3643	

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/750,913	SCHNEIDER, JON B.	
	Examiner	Art Unit	
	Jeffrey L. Gellner	3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 January 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *1-13,18 and 19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-17 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Invention II (claims 14-17 and 20) in the reply filed on 14 January 2005 is acknowledged. The traversal is on the ground(s) that: (1) according to 37 CFR 1.141(b) with the three categories of invention an election requirement is proper only if the process of making is distinct from the product (Remarks page 2, 3rd para.); and, (2) the searching of all or several of the inventions would not be a burden (Remarks page 3). This is not found persuasive because:

As to argument (1), the three inventions as shown in the restriction requirement are a method of using, product combination, and product subcombination. On its face, since a method of making is lacking, 37 CFR 1.141(b) is not applicable. Additionally, Examiner considers the method of using (Invention I) and the product combination (Invention II) to be distinct because the composition used in the method is a "self-coherent particulate magnetic material" and the composition in the product combination is a "particulate magnetic material and a particulate magnetic attracting material" (from claims 1 and 14 & 20) or a "particulate magnetic material and a particulate magnetically inert material" (from claim 16). These are distinct compositions.

As to argument (2), Examiner considers the different inventions present in the application to be a burden because of the different search requirements exemplified by the different classifications.

The requirement is still deemed proper and is therefore made FINAL. Claims 1-13, 18, and 19 are withdrawn from examination.

Specification

The disclosure is objected to because of the following informality:

The "particulate magnetically inert material" of claim 16, line 3, is not referenced in the specifcation.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15 and 17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15 and 17 are duplicates of one another.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14, 16, and 20 are rejected under 35 U.S.C. §102(b) as being anticipated by Kenmoku et al. (JP57-90087).

As to Claims 14 and 20, Kenmoku et al. discloses a self-coherent particulate magnetic material, or mulch, comprising a mixture of a particulate magnetic material ("ferromagnetic iron oxide" of the abstract in English) and a particluate magnetic attracting material ("K" or "phosphorus" of the abstract in English).

As to Claim 16, Kenmoku et al. discloses a self-coherent particulate magnetic material comprising a mixture of a particulate magnetic material ("ferromagnetic iron oxide" of the abstract in English) and a particluate magnetically inert material (in that some of the organic matter in the soil would be magnetically inert material; see abstract in English).

Claim Rejections - 35 USC §103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 15 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kenmoku et al. (JP57-90087).

As to claims 15 and 17, the limitations of Claim 14 are disclosed as described above. Not disclosed is the particulate magnetic material at least 50% by volume of the mixture. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the mixture of Kenmoku et al. by making the mixture at least 50% particulate magnetic material to achieve a particular goal since the particulate magnetic material can be applied either "by itself" or "in the form of a mixture with the soil" (from abstract in English).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Thetford et al., Wilson ('936), Dalton, Foth, Wilson ('093), Wilson ('222), Inoue, Haruna et al., Sasahara, and Aonuma disclose in the prior art various mixture with ferric/magnetic material which is capable of being used as a mulch. Schneider ('369 A1) discloses the instant application's pre-grant publication.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeffrey L. Gellner whose phone number is 571.272.6887. The Examiner can normally be reached Monday through Thursday from 8:30 am to 4:00 pm. The Examiner can also be reached on alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Peter Poon, can be reached at 571.272.6891. The official fax telephone number for the Technology Center where this application or proceeding is assigned is 703.872.9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.1113.

Jeffrey L. Gellner
Primary Examiner